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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,310	11/14/2003	Zhidong Chen	12475/50102	5753

26646 7590 03/30/2006

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EXAMINER	
GIBBS, TERRA C	
ART UNIT	**PAPER NUMBER**
1635	

DATE MAILED: 03/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/714,310	CHEN ET AL.	
	Examiner	Art Unit	
	Terra C. Gibbs	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-42 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-42 are pending in the instant application.

Claims 1-42 are subject to restriction as detailed below:

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1 and 3-8, drawn to an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:19, or an RNA sequence corresponding thereto, classifiable in class 536, subclass 24.5.

II. Claims 1 and 3-8, drawn to an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:36, or an RNA sequence corresponding thereto, classifiable in class 536, subclass 24.5.

III. Claims 9, 37, and 38, drawn to a method for inhibiting expression of bcl-2 comprising administering to a cell, tissue, or organism an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:19, or an RNA sequence corresponding thereto, classifiable in class 514, subclass 44.

IV. Claims 9, 37, and 38, drawn to a method for inhibiting expression of bcl-2 comprising administering to a cell, tissue, or organism an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:36, or an RNA sequence corresponding thereto, classifiable in class 514, subclass 44.

V. Claims 10-12, drawn to a method for detecting a nucleic acid encoding bcl-2 comprising hybridizing an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:19, or an RNA sequence corresponding thereto, classifiable in class 435, subclass 6.

VI. Claims 10-12, drawn to a method for detecting a nucleic acid encoding bcl-2 comprising hybridizing an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:36, or an RNA sequence corresponding thereto, classifiable in class 435, subclass 6.

VII. Claims 13, 15-20, drawn to an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:20, or an RNA sequence corresponding thereto, classifiable in class 536,

subclass 24.5.

VIII. Claims 13 and 15-20, drawn to an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:37, or an RNA sequence corresponding thereto, classifiable in class 536, subclass 24.5.

IX. Claims 21, 39, and 40, drawn to a method for inhibiting expression of bcl-2 comprising administering to a cell, tissue, or organism an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:20, or an RNA sequence corresponding thereto, classifiable in class 514, subclass 44.

X. Claims 21, 39, and 40, drawn to a method for inhibiting expression of bcl-2 comprising administering to a cell, tissue, or organism an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:37, or an RNA sequence corresponding thereto, classifiable in class 514, subclass 44.

XI. Claims 22-24, drawn to a method for detecting a nucleic acid encoding bcl-2 comprising hybridizing an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially

identical or complementary to at least a portion of SEQ ID NO:20, or an RNA sequence corresponding thereto, classifiable in class 435, subclass 6.

XII. Claims 22-24, drawn to a method for detecting a nucleic acid encoding bcl-2 comprising hybridizing an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:37, or an RNA sequence corresponding thereto, classifiable in class 435, subclass 6.

XIII. Claims 25-32, drawn to an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:21, or an RNA sequence corresponding thereto, classifiable in class 536, subclass 24.5.

XIV. Claims 33, 41, and 42, drawn to a method for inhibiting expression of bcl-2 comprising administering to a cell, tissue, or organism an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:21, or an RNA sequence corresponding thereto, classifiable in class 514, subclass 44.

XV. Claims 34-36, drawn to a method for detecting a nucleic acid encoding bcl-2 comprising hybridizing an isolated oligonucleotide comprising a

sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NO:21, or an RNA sequence corresponding thereto, classifiable in class 435, subclass 6.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups I and II are unrelated to the extent that they are drawn to materially distinct isolated oligonucleotides which are substantially identical or complementary to very different SEQ ID NOs., which require distinct materials and different objectives that require separate interpretation. For example, each Group is directed to an isolated oligonucleotide which is substantially identical or complementary to different SEQ ID NOs., which are entirely different oligonucleotides with very different physical properties and chemical structures. Each SEQ ID NO. is structurally and functionally independent, each from the other. For example, a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:19 of Group I would not encompass the art relevant to a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:36 of Group II. Searching, therefore is not coextensive. It would constitute a serious burden on the Examiner to search an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to

at least a portion of two different SEQ ID NOs., namely SEQ ID NOs: 19 and 36. Thus, they are patentably distinct from each other.

Inventions of Groups VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups VII and VIII are unrelated to the extent that they are drawn to materially distinct isolated oligonucleotides which are substantially identical or complementary to very different SEQ ID NOs., which require distinct materials and different objectives that require separate interpretation. For example, each Group is directed to an isolated oligonucleotide which is substantially identical or complementary to different SEQ ID NOs., which are entirely different oligonucleotides with very different physical properties and chemical structures. Each SEQ ID NO. is structurally and functionally independent, each from the other. For example, a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:20 of Group VII would not encompass the art relevant to a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:37 of Group VIII. Searching, therefore is not coextensive. It would constitute a serious burden on the Examiner to search an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of two different SEQ ID NOs., namely SEQ ID NOs: 20 and 37. Thus, they are patentably distinct from each other.

Inventions of Groups I, II, VII, VIII, and XIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have

different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups VII and VIII are unrelated to the extent that they are drawn to materially distinct isolated oligonucleotides which are substantially identical or complementary to very different SEQ ID NOs., which require distinct materials and different objectives that require separate interpretation. For example, each Group is directed to an isolated oligonucleotide which is substantially identical or complementary to different SEQ ID NOs., which are entirely different oligonucleotides with very different physical properties and chemical structures. Each SEQ ID NO. is structurally and functionally independent, each from the other. For example, a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NOs: 19 and 36 of Groups I and II would not encompass the art relevant to a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NOs: 20 and 37 of Groups VII and VIII. Similarly, a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NOs: 19 and 36 of Groups I and II would not encompass the art relevant to a search of an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:21 of Group XIII. Searching, therefore is not coextensive. It would constitute a serious burden on the Examiner to search an isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of very different SEQ ID NOs., namely SEQ ID NOs: 19, 20, 21, 36, and 37. Thus, they are patentably distinct from each other.

The Invention of Group I is related to the Inventions of Groups III and V as product

and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:19 of Group I can be used as a primer in a method of amplifying a nucleic acid encoding the bcl-2 gene (e.g. polymerase chain reaction assay), which is materially different than the method for inhibiting expression of bcl-2 in a cell, tissue, or organism of Group III or the method for detecting a nucleic acid encoding bcl-2 of Group V. Furthermore, restriction is proper because the subject matter is divergent and non-coextensive and a search for one Group would not necessarily reveal art against the other Group(s). It is therefore a burden to search all three of these inventions in a single application.

The Invention of Group II is related to the Inventions of Groups IV and VI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:36 of Group II can be used as a primer in a method of amplifying a nucleic acid encoding the bcl-2 gene (e.g. polymerase chain reaction assay), which is materially different than the method for inhibiting expression of bcl-2 in a cell, tissue, or organism of Group IV or the method for detecting a nucleic acid

encoding bcl-2 of Group VI. Furthermore, restriction is proper because the subject matter is divergent and non-coextensive and a search for one Group would not necessarily reveal art against the other Group(s). It is therefore a burden to search all three of these inventions in a single application.

The Invention of Group VII is related to the Inventions of Groups IX and XI as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:20 of Group VII can be used as a primer in a method of amplifying a nucleic acid encoding the bcl-2 gene (e.g. polymerase chain reaction assay), which is materially different than the method for inhibiting expression of bcl-2 in a cell, tissue, or organism of Group IX or the method for detecting a nucleic acid encoding bcl-2 of Group XI. Furthermore, restriction is proper because the subject matter is divergent and non-coextensive and a search for one Group would not necessarily reveal art against the other Group(s). It is therefore a burden to search all three of these inventions in a single application.

The Invention of Group VIII is related to the Inventions of Groups X and XII as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant

case the isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:37 of Group VIII can be used as a primer in a method of amplifying a nucleic acid encoding the bcl-2 gene (e.g. polymerase chain reaction assay), which is materially different than the method for inhibiting expression of bcl-2 in a cell, tissue, or organism of Group X or the method for detecting a nucleic acid encoding bcl-2 of Group XII. Furthermore, restriction is proper because the subject matter is divergent and non-coextensive and a search for one Group would not necessarily reveal art against the other Group(s). It is therefore a burden to search all three of these inventions in a single application.

The Invention of Group XIII is related to the Inventions of Groups XIV and XV as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the isolated oligonucleotide comprising a sequence which is substantially identical or complementary to at least a portion of SEQ ID NO:21 of Group XIII can be used as a primer in a method of amplifying a nucleic acid encoding the bcl-2 gene (e.g. polymerase chain reaction assay), which is materially different than the method for inhibiting expression of bcl-2 in a cell, tissue, or organism of Group XIV or the method for detecting a nucleic acid encoding bcl-2 of Group XV. Furthermore, restriction is proper because the subject matter is divergent and non-coextensive and a search for one Group would not necessarily reveal art against the other Group(s). It is therefore a burden to search all three of these inventions in a single application.

If either of Groups I or II are elected, claim 3 is subject to an additional restriction since it is not considered to be a proper genus/Markush. See MPEP 803.02 - PRACTICE RE MARKUSH-TYPE CLAIMS - If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction. Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Harnish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Claim 3 specifically claims an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NOs: 1-7, 14, or 22-25. Although the isolated oligonucleotides claimed are each inhibitory oligonucleotides targeted to bcl-2, the instant isolated oligonucleotides are considered to be unrelated, since each isolated oligonucleotide claimed is structurally and functionally independent and distinct for the following reasons: each isolated oligonucleotide has a unique nucleotide sequence and each isolated oligonucleotide targets a different and specific region of a bcl-2 nucleic acid. As such the Markush/genus of

isolated oligonucleotides in claim 3 are not considered to constitute a proper genus, and are therefore subject to restriction. Furthermore, a search of more than one (1) of the isolated oligonucleotides claimed in claim 3 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed isolated oligonucleotide sequence(s). In view of the foregoing, one (1) isolated oligonucleotide sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicants are required to elect one (1) isolated oligonucleotide from claim 3. Note that this is not a species election.

If either of Groups VII or VIII are elected, claim 15 is subject to an additional restriction since it is not considered to be a proper genus/Markush. See MPEP 803.02 - PRACTICE RE MARKUSH-TYPE CLAIMS - If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction. Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Harnish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Claim 15 specifically claims an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NOs: 8, 9 or 26-30. Although the isolated oligonucleotides claimed are each inhibitory oligonucleotides targeted to bcl-2, the instant isolated oligonucleotides are considered to be unrelated, since each isolated oligonucleotide claimed is structurally and functionally independent and distinct for the following reasons: each isolated oligonucleotide has a unique nucleotide sequence and each isolated oligonucleotide targets a different and specific region of a bcl-2 nucleic acid. As such the Markush/genus of isolated oligonucleotides in claim 15 are not considered to constitute a proper genus, and are therefore subject to restriction. Furthermore, a search of more than one (1) of the isolated oligonucleotides claimed in claim 15 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed isolated oligonucleotide sequence(s). In view of the foregoing, one (1) isolated oligonucleotide sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicants are required to elect one (1) isolated oligonucleotide from claim 15. Note that this is not a species election.

If Group XIII is elected, claim 27 is subject to an additional restriction since it is not considered to be a proper genus/Markush. See MPEP 803.02 - PRACTICE RE MARKUSH-TYPE CLAIMS - If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require

restriction. Since the decisions in In re Weber, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and In re Haas, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. In re Harnish, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and Ex parte Hozumi, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Claim 27 specifically claims an isolated oligonucleotide comprising a sequence of at least 8 contiguous nucleobases which is substantially identical or complementary to at least a portion of SEQ ID NOs: 10-13 or 31-34. Although the isolated oligonucleotides claimed are each inhibitory oligonucleotides targeted to bcl-2, the instant isolated oligonucleotides are considered to be unrelated, since each isolated oligonucleotide claimed is structurally and functionally independent and distinct for the following reasons: each isolated oligonucleotide has a unique nucleotide sequence and each isolated oligonucleotide targets a different and specific region of a bcl-2 nucleic acid. As such the Markush/genus of isolated oligonucleotides in claim 27 are not considered to constitute a proper genus, and are therefore subject to restriction. Furthermore, a search of more than one (1) of the isolated oligonucleotides claimed in claim 27 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed isolated oligonucleotide sequence(s). In view of the foregoing, one (1) isolated oligonucleotide sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicants are required to elect one (1)

isolated oligonucleotide from claim 27. Note that this is not a species election.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Claims 2 links the inventions of Groups I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim, claim 2. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claims 14 links the inventions of Groups VII and VIII. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim, claim 14. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or

divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with

the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terra C. Gibbs whose telephone number is 571-272-0758. The examiner can normally be reached on 9 am - 5 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tcg
March 27, 2006